

REMARKS

Claims 1-9 are pending in the above-identified application and were rejected. With this Amendment, claims 1 and 5 are amended. Claims 10-17 are new. No new matter has been added. Accordingly, claims 1-17 are at issue.

I. 35 U.S.C. § 103 Obviousness Rejection of Claims

Claims 1, 5 and 9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. Publication No. 2001/0050717) in view of Miyaguchi et al. (U.S. Patent No. 5,508,740). Claims 2, 3, 6, and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamada et al. (U.S. Publication No. 2001/0050717) in view of Miyaguchi et al. (U.S. Patent No. 5,508,740) and further in view of Ackland et al. (Non-Patent Literature). Claims 4 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Yamada et al. (U.S. Publication No. 2001/0050717) in view of Miyaguchi et al. (U.S. Patent No. 5,508,740) and further in view of Tullis (U.S. Patent No. 6,535,243). Applicants respectfully traverse these rejections.

Claim has been amended to clarify that “the circuit board is disposed between the sensor package and the optical unit.” Yamada et al. does not disclose or suggest a circuit board having an opening, wherein “the circuit board is disposed between the sensor package and the optical unit.”

In Yamada et al., a CMOS camera system has a stepped wiring board 21 that has an image pick-up opening 22. (See page 2, ¶ 41.) The stepped wiring board has recesses 26 formed in its surface. (See page 2, ¶ 41.) An image pick-up semiconductor 4 and an image processing semiconductor 9 *are connected to the recesses 26 of the stepped wiring board 21*, and so are disposed within the recesses 26 of the stepped wiring board 21. (page 2, ¶ 43; Figs. 1-10.) Thus,

Yamada et al. does not disclose or suggest a circuit board having an opening, wherein the circuit board is disposed between the sensor package and the optical unit, as recited in claim 1.

Additionally, as acknowledged by the Examiner, Yamada et al. does not disclose or suggest a sensor package in which a chip of a solid-state image pickup element is placed, and a seal adhered to the sensor package for sealing in the solid-state image pickup element, wherein the seal is placed within the opening of the circuit board. The Examiner asserts that these limitations are present in Miyaguchi et al. Assuming *arguendo* that all of the limitations of independent claim 1 are disclosed in Yamada et al. and/or Miyaguchi et al., Applicants respectfully submit that the Examiner has not made a prima facie case of obviousness. Obviousness requires that the combined references teach or suggest each element in the claim.

The Examiner has not shown where in any of the references there is a teaching or suggestion that would have motivated one of ordinary skill in the art to make the combinations asserted by the Examiner. Rather, the Examiner provides a conclusory statement that “it would have been obvious to one of ordinary skill in the art to house the chip of Yamada et al. in the package of Miyaguchi et al., because an artisan of ordinary skill would recognize that this would allow for photodetection with high S/N ratio.” The Examiner’s statement that a combination of prior art would have been recognized by one of ordinary skill in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. (See MPEP §2143.01.) Because the Examiner has not established a prima facie case of obviousness, the obviousness rejection of claim 1 is improper and should therefore be withdrawn.


For all of the reasons set forth above, claim 1 and claims 2-4, 9 and 15 that depend from claim 1 are allowable over the cited references. For reasons similar to those discussed regarding claim 1, Applicants respectfully submit that claims 5-8, 10-14 and 16-17 are also allowable over the cited references. Accordingly, Applicants respectfully request withdrawal of these rejections.

II. Conclusion

In view of the above amendments and remarks, Applicants submit that all claims are clearly allowable over the cited prior art, and respectfully request early and favorable notification to that effect.

Respectfully submitted,

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By: 
Marina N. Saito
Registration No. 42,121
SONNENSCHN NATH & ROSENTHAL LLP
P.O. Box 061080
Wacker Drive Station, Sears Tower
Chicago, Illinois 60606-1080
(312) 876-8000

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